

## **REMARKS**

Reconsideration and withdrawal of the rejection and the allowance of all claims now pending in the above-identified patent application (*i.e.*, Claims 25-28 and 30) are respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, it should again be recognized that the present invention provides a method for cosmetically increasing the size of the human breast, which includes the steps of applying cocoa butter to a human breast for a larger breast size of the human breast, as compared to the original breast size, and applying Vitamin E to the human breast of increased breast size for sustaining the larger breast size. The steps of applying cocoa butter to the human breast may be carried out prior to the application of Vitamin E or the steps of applying cocoa butter and Vitamin E may be performed simultaneously.

As will be explained in greater detail hereinafter, nowhere in the prior art is such a novel, effective and economical method for increasing the size of the human breast, which avoids surgery, either disclosed or suggested.

The present Response is being filed by the undersigned patent attorney at the request of Applicant. At this time, the Patent and Trademark Office should continue to correspond with the inventor until such time as a formal power-of-attorney is provided for the undersigned. The Examiner, however, may choose to confer via telephone with the undersigned regarding this patent application and, most particularly, the amendments and argument presented herein.

By the present amendments, Applicant has cancelled dependent Claims 29 and 31 for the purpose of rendering moot the Examiner's non-enablement rejection of these claims, pursuant to 35 U.S.C. §112, first paragraph, in the final Office Action.

Accompanying the instant Reponse, Applicant is filing a further Information Disclosure Statement, as required by the Examiner in the final Office Action (at pp. 2-3), forwarding copies of all relevant references known, and currently available, to Applicant. Applicant and her attorney appreciate the Examiner's indication that the fee and certification requirements, pursuant to 37 C.F.R. §1.97, are waived for the enclosed Information Disclosure Statement, though the requirements of 37 C.F.R. §1.97 are submitted to be moot in light of Applicant's filing of a Request for Continued Examination under 37 C.F.R. §1.114. It is, therefore, respectfully submitted to be unnecessary to determine whether the IDS now being filed by Applicant extends beyond the scope of the Examiner's requirements, issued under 37 C.F.R. §1.105.

The Request for Continued Examination is accompanied by the RCE filing fee of \$395.00 (small entity), and a formal Petition for a Three-Month Extension of time for Response and the requisite extension fee of \$510.00 (small entity), covered by the enclosed check in the amount of \$905.00. The Request for Continued Examination further maintains the pendency of the above-identified patent application beyond the six-month statutory deadline of Monday, November 7th, 2005. By virtue of the accompanying Request for Continued Examination, the finality of the last Office Action should be formally withdrawn.

As part of the latest Office Action, the Examiner has again rejected Applicant's pending claims, pursuant to 35 U.S.C. §101, on the contention that the presently claimed invention, directed toward a sustainable, non-surgical breast enlargement through the continued application of cocoa butter and Vitamin E, is not supported by either credible asserted utility or well-established utility, *i.e.*, the claimed invention lacks utility. The Examiner has also issued a related rejection of the claims under the first paragraph of 35 U.S.C. §112, essentially as being non-enabled.

In response to the Examiner's lack-of-utility rejection of Applicant's claims, Applicant has now arranged for a medical study to be conducted by Dr. Gilles Marion, of 55 de l'Eglise Avenue, Suite 32, Montreal (Verdun), H4G 3E7, Canada (Telephone No. (514)769-2777), to credibly establish the utility of Applicant's invention. A letter from Dr. Gilles, dated November 3rd, 2005, along with an outline of the study to be conducted by him, is attached to this Response.

In view of the study now being conducted to credibly determine the utility of Applicant's claimed invention, it is respectfully requested that Examiner's requirement that Applicant establish the utility of her invention, in reply to the related lack-of-utility and non-enablement rejections issued under 35 U.S.C. §§101 and 112, first paragraph, respectively, should be held in abeyance.

Turning now, in detail, to an analysis of the Examiner's prior art rejections of Applicant's claims, in the final Office Action the Examiner has rejected Claims 25-31 (now pending Claims 25-28 and 30) as being obvious, pursuant to 35 U.S.C. §103(a),

over Russell, Chicago Daily Tribune (1911); and Martineau, Chicago Daily Tribune (1903). With respect to each of Russell and Martineau, it is the Examiner's contention that each of the applied non-patent printed publications disclose a method of enlarging a human breast with cocoa butter. The Examiner has, however, acknowledged that neither Russell nor Martineau disclose the use of Vitamin E in any such breast enlargement method. The Examiner has, nevertheless contended that the added application of Vitamin E to the breast would be obvious.

In reply to the Examiner's obviousness rejections applying Russell and Martineau, inasmuch as Applicant's claimed method includes the step of applying Vitamin E for sustaining the enlarged breast size otherwise achieved by the application of cocoa butter to the breast, and since neither Russell nor Martineau, taken singularly or in combination, teach or suggest the further application of Vitamin E for sustaining breast size - or suggest the application of Vitamin E for any purpose - it is respectfully submitted that both of the 35 U.S.C. §103(a) obviousness rejections, which apply Russell and Martineau, should be withdrawn as failing to teach or suggest a critical step of Applicant's claimed method.

Further, the Examiner's contention contained in her "*Response to Arguments*" (at Page 7 of the final Office Action) that, somehow, the use of Vitamin E as "obvious" is to now be considered "admitted prior art" because Applicant did not specifically rebut a contention of the Examiner, while successfully overcoming Cayce as an applied citation in an obviousness rejection issued in the previous Office Action, lacks any legal basis

whatsoever in patent law. "Admitted prior art" consists of a statement by a patent applicant - not an Examiner! - whereby the patent applicant expressly (and not be mere implication) identifies the work or another person as "prior art," even if such other person's work might not have otherwise qualified as "prior art" under any statutory provision. *See, Manual of Patent Examining Procedure*, §2129, *citing, Riverwood International Corp. v. R. A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003). As a practical matter, probably the most common situation where "admitted prior art" arises is where a non-patent printed publication lacks a clear or unambiguous date of publication, but is conceded to be "prior art" as an admission of the obvious by a patent applicant, who then proceeds to discuss the admitted prior art on its merits.

Under no circumstances can a contention of an Examiner regarding the scope of a prior art reference "entrap" an applicant into somehow admitting, or agreeing, with the Examiner's interpretation of what a particular reference teaches or suggests when the applicant expressly argues against the reference as adversely affecting patentability and, most particularly, when the applicant's arguments for patentability are accepted by the Examiner, who then proceeds to withdraw the rejection which applied the prior art reference.

Cayce, as applied in an obviousness rejection in the non-final Office Action, dated August 2, 2004, is "prior art" for everything that it discloses and reasonably suggests to those skilled in the relevant technical art. The scope of what Cayce teaches and reasonably suggests cannot be expanded by a contention offered by an Examiner, regardless of

whether the Applicant expressly addresses the particularly contention when rebutting Cayce, and regardless of whether the arguments favoring patentability are even accepted by the Examiner.

Both Applicant and the Examiner are in agreement that neither Russell nor Martineau disclose the use of Vitamin E. Cayce, for the record, also fails to teach or suggest the use of Vitamin E. No comments by Applicant's representative implied otherwise and there is respectfully submitted to be no basis in the law for reading any comments by Applicant or her representative as otherwise admitting to any prior art that lacks a clear statutory basis for citation or for what any such prior art might teach or suggest. It is therefore respectfully contended that it would not be proper for the Examiner to combine either of Russell and/or Martineau with any supposed admission of what Cayce might teach in an effort to hold Applicant's claimed invention as obvious.

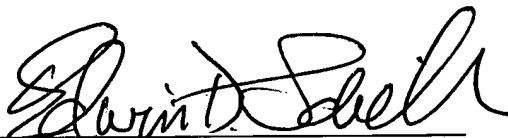
In view of the foregoing, Applicant respectfully submits that the 35 U.S.C. §103(a) obviousness rejections of the final Office Action, which apply Russell and Martineau, have been overcome and should be appropriately withdrawn.

In light of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (*i.e.*, Claims 25-28 and 30) recite a novel method for enlarging the human breast, and sustaining the increased breast size by applying Vitamin E, which is patentably distinguishable over the prior art. Accordingly, withdrawal of the outstanding rejections and the allowance of all claims now pending in the

instant patent application (subject to completing the utility study now underway in Montreal) are respectfully requested and earnestly solicited.

Respectfully submitted,

MARIANTHI GIAKOUMAKIS

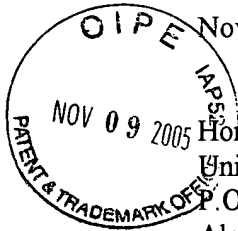
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November 7, 2005

- Enc.: 1. Request for Continued Examination under 37 C.F.R. §1.114;
2. Petition for Three-Month Extension of Time for response;
3. Applicant's Check for \$905-RCE Filing Fee of \$395 + Extension Fee of \$510;
4. Letter of Dr. Gilles Marion, dated November 3, 2005 w/Proposed Study; and,
5. Information Disclosure Statement w/Form PTO-1449 and cited references.



November 3, 2005

Hon. Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Re: U.S. patent application number 08/876,437  
Applicant: Giakoumakis, Marianthi  
Title: Non-Surgical Method for Breast Augmentation

Dear Sir:

This is to affirm that, re the above-captioned patent application, a study is currently underway under my supervision in order to determine if using cocoa-butter and vitamin E is a viable alternative to surgery for the purpose of sustained breast augmentation.

Should you have any questions, please do not hesitate to contact the undersigned.

Sincerely,

Dr. Gilles Marion  
55 de l'Eglise avenue, suite 32  
Montreal (Verdun), H4G 3E7 Canada  
Telephone : (514) 769-2777

Proposed Study Outline of Steps of the the above-named patent application :

1.

Doctor wishes to use 12 volunteers.

2.

Volunteer's first doctor's visit consists of :

Doctor first checks volunteer to be free from signs of pathology of the breasts.

Doctor takes pertinent measurements of the volunteer.

3.

Next :

-Volunteer applies step 1 only (cocoa-butter).

-Volunteer is examined again by doctor and doctor takes pertinent measurements of the volunteer.

-A number of days later, the Volunteer is examined again by doctor to verify that volunteer has lost the augmentation gained from the application of step 1 (cocoa-butter).

-Doctor takes pertinent measurements of Volunteer.

4.

Next :

-On another day Volunteer applies step 1 (cocoa-butter) and also step 2 (vitamin E).

-Volunteer is examined again by doctor and doctor takes pertinent measurements of the Volunteer.

-A number of days later, the Volunteer is again examined by doctor to verify if Volunteer has kept any augmentation gained from the application of steps 1 (cocoa-butter) and step 2 (vitamin E).

-Doctor takes pertinent measurements of volunteer.

5.

Next :

Depending on the body's response of each particular Volunteer, Doctor determines if Volunteer should again make another application of step 1 (cocoa-butter) and step 2 (vitamin E) in order to make obvious that any increase in the size of the breast is due to the augmentation gained by the application of step1 (cocoa-butter) and step 2 (vitamin E). At this time, the augmentation gained by the Volunteer should be cumulative, in other words, the volunteer should show a gain in breast size for the total of two applications of step1 (cocoa-butter) and also step 2 (vitamin E).

Doctor takes pertinent measurements of the Volunteer.

Please note: Any other applications by the Volunteer for further sustained breast augmentation by the use of step 1 (cocoa-butter) and also step 2 (vitamin E) would be at the discretion of the Doctor.

6.

Pertinent photographs of the Volunteer re the above study are taken for the purpose of further verification of sustained augmentation of Volunteer's breast size.